

Appln. No. 09/856,335
Amdt. dated April 19, 2005
Reply to Office action of August 23, 2004

REMARKS/ARGUMENTS

Claims 1-35 were pending in the application. Claims 1, 10, 12, 14, 24, 28, 32, 34 and 35 were rejected. No claims were merely objected to and no claims were allowed. By the foregoing amendment, no claims are canceled, no claims are amended, and claim 36 is added. No new matter is presented.

Claim Rejections under 35 U.S.C. 103

The Examiner rejected claims 1, 10, 12, 14, 24, 28, and 32-34 as being unpatentable over Inoue et al. (US 5,143,746) in view of Savkar et al. (US 5,047,612) and Moreau et al. (US 5,180,921). Applicant respectfully traverses the rejection.

It was asserted that it would have been obvious "to modify Inoue to use both the on-line monitoring and control systems suggested by Savkar and Moreau in order to provide optimized deposition of the coating onto the substrate because Inoue teaches a plasma spray system of depositing magnetite onto a substrate surface and Savkar and Moreau teach the desirability of using on-line monitoring and control systems when plasma spraying..." Office action, page 6, paragraph 2.

The three references all substantially predate the present application. Although the age of the references is not, of itself, relevant, it does provide a substantial period of time in which the intervening art may teach away from the proposed combination. This teaching away is evidenced by the conspicuous lack of the combination being taught by the intervening art, thus confirming nonobviousness. For example, in the present Office action, much later references such as Schutz (US 5,912,471) and Bourque et al. (US 5,986,277) are cited as

Appln. No. 09/856,335
Amdt. dated April 19, 2005
Reply to Office action of August 23, 2004

background but have not been cited as anticipatory or further supporting the grounds of rejection. If the presently-claimed invention had been obvious, later references such as Schutz and Bourque et al. would have disclosed it.

The examiner rejected claim 35 as being unpatentable over Inoue et al. in view of Savkar et al. and Moreau et al. as previously applied and further in view of Yoshinaka et al. (US 5,158,643). Applicant respectfully traverses the rejection.

The four-reference combination would not have been obvious for the same reasons as the underlying three-reference combination discussed above.

New claim 36 is supported by existing claim 1 but more explicitly identifying relationships between the method steps. Accordingly, new claim 36 is also patentable.

The examiner requested the missing priority document. In the interest of advancing examination, this is being submitted by mail under separate cover to permit the present correspondence to be sent via facsimile.

An earnest and thorough attempt has been made by the undersigned to resolve the outstanding issues in this case and place same in condition for allowance. If the Examiner has any questions or feels that a telephone or personal interview would be helpful in resolving any outstanding issues which remain in this application after consideration of this amendment, the Examiner is courteously invited to telephone the undersigned and the same would be gratefully appreciated.

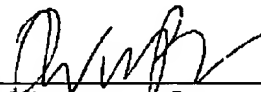
Appln. No. 09/856,335
Amdt. dated April 19, 2005
Reply to Office action of August 23, 2004

It is submitted that the claims as amended herein patentably define over the art relied on by the Examiner and early allowance of same is courteously solicited.

If any additional fees are required in connection with this case, it is respectfully requested that they be charged to Deposit Account No. 02-0184.

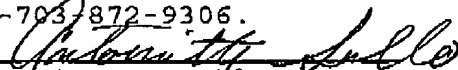
Respectfully submitted,

ERICH LUGSCHEIDER

By 
William B. Slate
Attorney for Applicant
Reg. No. 37,238
Tel: (203) 777-6628
Fax: (203) 865-0297

Date: April 19, 2005

I hereby certify that this correspondence is being faxed this 19th day of April, 2005 to the USPTO, at Fax No. 1-703-872-9306.


Antoinette Suilo

01-329 Amdt AF.doc